

### III. REMARKS

#### *Claim Rejections - 35 U.S.C. 101 Double Patenting*

Claims 11 and 12 stand rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of prior US 6,720,137. This is a double patenting rejection.

Claim 11 has been amended to change the scope and to differentiate them from claims 1 and 2 of US 6,720,137.

Further, applicant transmits herewith a terminal disclaimer disclaiming the period after the termination date of US 6,720,737, thus obviating this ground for rejection.

#### *Claim Rejections - Nonstatutory Double Patenting*

Claims 11-12 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of US 6,720,737.

Applicant transmits a terminal disclaimer herewith disclaiming the period after the termination date of US 6,720,737, thus obviating this ground for rejection.

#### *Claim Rejections - 35 U.S.C. § 112, second paragraph*

Claims 11, 12, and 13 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite because it is internally inconsistent, and therefore confusing in that part (a) of claim 11 requires that the "one or more oligonucleotide primer pairs" used in the method hybridize to a region of chromosomal DNA that

"comprises a repeated dinucleotide motif comprising at least one of the following selected from the group consisting of (GA:CT) $n$ , (GA:CA) $n$ , and (AT:TA) $n$ , wherein  $n \geq 10$ ." Part (b) sets forth that each of the "one or more oligonucleotide primer pairs" consist of particular first and second oligonucleotides so that the primer pairs are selected from the pairs SEQ ID NO: 1 and 2, SEQ ID NO: 3 and 4, SEQ ID NO: 5 and 6, SEQ ID NO: 7 and 8, SEQ ID NO: 9 and 10, SEQ ID NO: 11 and 12, SEQ ID NO: 13 and 14, SEQ ID NO: 15 and 16, SEQ ID NO: 17 and 18 or SEQ ID NO: 19 and 20.

However, as stated by the examiner not all of these primer pairs amplify regions that meet the limitations of part (a) of the claims.

The examiner suggests that if claim 11 were amended to recite "wherein said region of the DNA comprises a repeated motif" and the language "comprises a repeated dinucleotide motif comprising at least one of the following selected from the group consisting of (GA:CT) $n$ , (GA:CA) $n$ , and (AT:TA) $n$ , wherein  $n \geq 10$ " were deleted, this rejection would be overcome.

Applicant thanks the examiner for her consideration and the suggestion of proposed clarifying language. Applicant has incorporated the suggested changes into the claims thus obviating this ground for rejection.

Claim 13 is further rejected as being indefinite because the claim recites that the method of claim 11 must further comprise one or more primer pairs from those listed, however it is not clear what it means for a method to comprise a primer

pair.

Claim 13 has now been cancelled and rewritten as independent method claim 14, thus obviating this ground for rejection.

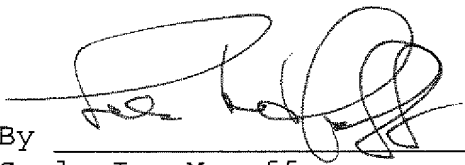
Claim 15 tracks claim 12 but with respect to the limited primer pairs set forth in claim 14.

Favorable reconsideration is respectfully requested.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By   
Serle Ian Mosoff  
Attorney for Applicant(s)  
Reg. No. 25,900

875 Third Avenue - 18<sup>th</sup> Floor  
New York, New York 10022  
Phone: (212) 808-0700  
Fax: (212) 808-0844